

Remarks

The Office Action mailed September 17, 2001 has been carefully reviewed and the foregoing amendments have been made in consequence thereof. Submitted herewith is a Submission of Marked Up Claims.

Claims 1-18 are now pending in this application. Claims 1-18 stand rejected.

The objection to the drawings is respectfully traversed. Under 37 C.F.R. 1.83(a), conventional features disclosed in the description and claims need not be shown in the drawings where their detailed illustration is not essential for a proper understanding of the invention. Applicants respectfully submit that illustrations of the grill configured to attach to a first motor assembly and a second, larger motor assembly is not necessary for an artisan of ordinary skill in the art to understand the invention, and as such, are not essential for a proper understanding of the disclosed invention. Furthermore, Applicants submit that an artisan of ordinary skill in the art would understand the invention after reading the specification in view of the current drawings. For the reasons set forth above, Applicants request that the objection to the drawings be withdrawn.

For the reasons set forth above, Applicants request that the objections to the drawings be withdrawn.

The rejection of Claims 5-10 under 35 U.S.C. §112, second paragraph, is respectfully traversed. More specifically, Claim 5 has been amended to recite "the first motor assembly", at line 2. As such, Applicants submit that Claim 5 particularly points out and distinctly claims the subject matter regarded as the invention, and thus is definite. Claims 6-10 depend, directly or indirectly, from independent Claim 5. When the recitations of Claims 6-10 are considered in combination with the recitations of Claim 5, Applicants submit that Claims 6-10 likewise are definite. For the reasons set forth above, Applicants request that the Section 112 rejection of Claims 5-10 be withdrawn

The rejection of Claims 1, 5-8, and 11-16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,686,773 (Sakakibara et al.) is respectfully traversed.

Sakakibara et al. describe an alternator 2 that includes a plurality of generally triangular engine-mounting stays 61 and 62 that are secured to an engine. A plurality of stay reinforcement ribs 71 and 72 are integrally formed with engine-mounting stays 61 and 62 and with alternator 2, and facilitate increasing the rigidity of stays 61 and 62.

Claim 1 recites a method for mounting a grill to one of a first motor assembly and a second larger motor assembly, wherein the first motor includes an endshield that includes a plurality of openings, the openings are for attaching the first motor assembly to the grill, and the method comprises the step of "attaching the grill to one of the first motor assembly and the second motor assembly using the plurality of openings."

Sakakibara et al. do not describe nor suggest a method for mounting a grill to one of a first motor assembly and a second larger motor assembly, wherein the first motor includes an endshield that includes a plurality of openings, the openings are for attaching the first motor assembly to the grill, and the method includes the step of attaching the grill to one of the first motor assembly and the second motor assembly using the plurality of openings. Specifically, Sakakibara et al. do not describe nor suggest attaching a grill to one of a first motor assembly and a second motor assembly using a plurality of openings. Rather, Sakakibara et al. describe an alternator that includes a plurality of generally triangular engine-mounting stays that are secured to an engine. For the reasons set forth above, Claim 1 is submitted to be patentable over Sakakibara et al.

Claim 2 depend from independent Claim 1. When the recitations of Claim 2 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claim 2 likewise is patentable over Sakakibara et al.

Claim 5 recites an endshield for a first motor assembly configured to attach to a grill, wherein the endshield comprises "a plurality of openings for attaching said endshield to the grill."

Sakakibara et al. does not describe nor suggest an endshield for a first motor assembly configured to attach to a grill, wherein the endshield includes a plurality of openings for attaching said endshield to the grill. Rather, Sakakibara et al. describe an alternator that includes a plurality of generally triangular engine-mounting stays that are secured to an engine. For the reasons set forth above, Claim 5 is submitted to be patentable over Sakakibara et al.

Claims 6-8 depend, directly or indirectly, from independent Claim 5. When the recitations of Claims 6-8 are considered in combination with the recitations of Claim 5, Applicants submit that dependent Claims 6-8 likewise are patentable over Sakakibara et al.

Claim 11 recites a motor assembly that comprises "a grill configured to attach to one of a first motor assembly and a second larger motor assembly".

Sakakibara et al. do not describe nor suggest a motor assembly that comprises a grill configured to attach to one of a first motor assembly and a second larger motor assembly. Rather, Sakakibara et al. describe an alternator that includes a plurality of generally triangular engine-mounting stays that are secured to an engine. For the reasons set forth above, Claim 11 is submitted to be patentable over Sakakibara et al.

Claims 12-16 depend, directly or indirectly, from independent Claim 11. When the recitations of Claims 12-16 are considered in combination with the recitations of Claim 11, Applicants submit that dependent Claims 12-16 likewise are patentable over Sakakibara et al.

For the reasons set forth above, Applicants respectfully request that the Section 102 rejection of Claims 1, 2, 5-8, and 11-16 be withdrawn.

The rejection of Claims 3, 4, 9, 10, 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over Sakakibara et al. is respectfully traversed.

Sakakibara et al. are described above. Grube describes a self-clinching pierce fastener, or nut, 10 and a panel 11, and an associated method of attaching nut 10 to panel 11.

Marik describes a conduit connector 20 that movably connects a conduit saddle 36 to a connector body 22.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. None of Sakakibara et al., Grube, or Marik, considered alone or in combination, describe or suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Sakakibara et al. with Grube or Marik, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory statement that "[i]t would have been obvious an obvious matter of design choice to design the end shield and to provide well known [in] the art self tapping fastener or the self clinching nut (Re US Patent 3,693,237 to Grube and 5,905,230 to Marik) for the purpose of reducing the cost of the shield installing the end shield to sheet material, since applicant has not disclosed that these features solve any stated problem or is for any particular purpose it appears that the invention would perform equally well with fastener and threaded hole system" suggests combining the disclosures.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such

references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn.

Further, and to the extent understood, none of Sakakibara et al., Grube, or Marik, considered alone or in combination, describe or suggest the claimed combination, and as such, the presently pending claims are patentably distinguishable from the cited combination. More specifically, Claims 3 and 4 depend, directly or indirectly, from independent Claim 1 which recites a method for mounting a grill to one of a first motor assembly and a second larger motor assembly, wherein the first motor includes an endshield that includes a plurality of openings, the openings are for attaching the first motor assembly to the grill, and the method comprises the step of "attaching the grill to one of the first motor assembly and the second motor assembly using the plurality of openings."

None of Sakakibara et al., Grube, or Marik describe or suggest a method for mounting a grill to one of a first motor assembly and a second larger motor assembly, wherein the first motor includes an endshield that includes a plurality of openings, the openings are for attaching the first motor assembly to the grill, and the method includes the step of attaching the grill to one of the first motor assembly and the second motor assembly using the plurality of openings. Specifically, none of Sakakibara et al., Grube, or Marik describe or suggest attaching a grill to one of a first motor assembly and a second motor assembly using a plurality of openings. Rather, Sakakibara et al. describe an alternator that includes a plurality of generally triangular engine-mounting stays that are secured to an engine, Grube describes a self-clinching pierce fastener, or nut, and a panel, and a method of attaching the nut to the panel, and Marik describes a conduit connector that movably connects a conduit saddle to a connector body. For the reasons set forth above, Claim 1 is submitted to be patentable over Sakakibara et al., Grube, and Marik.

Claims 3 and 4 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 3 and 4 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 3 and 4 likewise are patentable over Sakakibara et al., Grube, and Marik.

Claims 9 and 10 depend, directly or indirectly, from independent Claim 5 which recites an endshield for a first motor assembly configured to attach to a grill, wherein the endshield comprises "a plurality of openings for attaching said endshield to the grill."

None of Sakakibara et al., Grube, or Marik describe or suggest an endshield for a first motor assembly configured to attach to a grill, wherein the endshield includes a plurality of openings for attaching said endshield to the grill. Rather, Sakakibara et al. describe an alternator that includes a plurality of generally triangular engine-mounting stays that are secured to an engine, Grube describes a self-clinching pierce fastener, or nut, and a panel, and a method of attaching the nut to the panel, and Marik describes a conduit connector that movably connects a

conduit saddle to a connector body. For the reasons set forth above, Claim 5 is submitted to be patentable over Sakakibara et al., Grube, and Marik.

Claims 9 and 10 depend, directly or indirectly, from independent Claim 5. When the recitations of Claims 9 and 10 are considered in combination with the recitations of Claim 5, Applicants submit that dependent Claims 9 and 10 likewise are patentable over Sakakibara et al., Grube, and Marik.

Claims 17 and 18 depend, directly or indirectly, from independent Claim 11 which recites a motor assembly that comprises "a grill configured to attach to one of a first motor assembly and a second larger motor assembly".

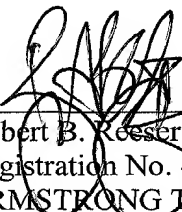
None of Sakakibara et al., Grube, or Marik describe or suggest a motor assembly that comprises a grill configured to attach to one of a first motor assembly and a second larger motor assembly. Rather, Sakakibara et al. describe an alternator that includes a plurality of generally triangular engine-mounting stays that are secured to an engine, Grube describes a self-clinching pierce fastener, or nut, and a panel, and a method of attaching the nut to the panel, and Marik describes a conduit connector that movably connects a conduit saddle to a connector body. For the reasons set forth above, Claim 11 is submitted to be patentable over Sakakibara et al., Grube, and Marik.

Claims 17 and 18 depend, directly or indirectly, from independent Claim 11. When the recitations of Claims 17 and 18 are considered in combination with the recitations of Claim 11, Applicants submit that dependent Claims 17 and 18 likewise are patentable over Sakakibara et al., Grube, and Marik.

For the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 3, 4, 9, 10, 17, and 18 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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PATENT

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Ashe et al. :
Serial No.: 09/617,896 : Art Unit: 2834
Filed: July 17, 2000 : Examiner: J. Waks
For: METHODS AND APPARATUS :
FOR ATTACHING A GRILL :
FOR A MOTOR :

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SUBMISSION OF MARKED UP CLAIMS

Hon. Assistant Commissioner for Patents
Washington, D.C. 20231

In response to the Office Action dated April 6, 2001, please amend the above-identified patent application as follows:

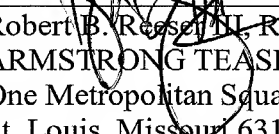
MARKED UP CLAIMS

5. (once amended) An endshield for a first motor assembly configured to attach to a grill, the grill configured to attach to one of [a] the first motor assembly and a second larger motor assmebly, said ensield comprising:

a plurality of attachment points for attaching said endshield to the first motor assembly;
and

a plurality of openings for attaching said endshield to the grill.

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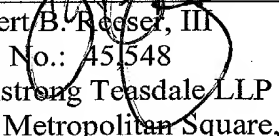
Express Mail mailing label number: **EV016943118US**

Date of Mailing:, **December 17, 2001**

I certify that the attached **Amendment of Lester Bruce Ashe, Jr., et al., Serial No.: 09/617,896 filed July 17, 2000, for METHODS AND APPARATUS FOR ATTACHING A GRILL TO A MOTOR (Attorney Docket No.: 03-DV-7038)** including:

- Amendment Transmittal (3 pgs. In duplicate)
- Amendment In Response to Office Action dated 09/17/2001 (9 pgs.)
- Submission of Marked-Up Claims (1 pgs.)
- Certificate of Mailing via Express Mail (1 pg.)
- Return postcard

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above in an envelope addressed to Commissioner for Patents, Arlington, VA 22202-0327.


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